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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/535,082	03/23/00	RIVKIN	B

EXAMINER

PM82/0615

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ART UNIT	PAPER NUMBER
3626	11

DATE MAILED: 06/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/535,082	RIVKIN
Examiner	**Art Unit**
Victor Sakran	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *THREE* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *May 25, 2001* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above, claim(s) *1-13* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *14-17 and 19-24* is/are rejected.

7) ☒ Claim(s) *18* is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 20 (second occurrence) -23, have been renumbered as claims 21-24, respectively, in order to comply with 37 CFR 1.126 .

Claim Rejections - 35 USC § 112

2. Claim 22, is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. since the term "may be" as recited in said claim is vague and not a positive recitation .

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 14-17, 19 and 24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller U. S. Patent No. 5,682,648 (of record) in view of Ward, II U. S. Patent No. 4,894,887 (newly cited) and Markowitz U. S. Patent No. 2,644,212 (of record) .

Miller discloses the general combination claimed of a magnetic device adapted to be attached to a garment comprising a magnet provided with a bridge forming an opening for insertion an item therethrough in combination with magnetically keeper plate ; see Figure 2B, 3A, 3B, 4 ; claims 1-

4, and the entire document, except that the magnet device is adapted to hold an eyeglass instead of the stems of flowers, a housing for the magnet and the type of material used to form the magnet . Ward, II teaches the use of an eyeglass holder device for releasable attachment to a garment including a bridge having an opening formed therein for inserting an eyeglass temple piece therein ; see 1, 2, and the entire document .Markowitz teaches the use of a magnet which is formed of different-type of material including a housing for receiving its magnet, see Figures 1, 3, 5 ; column 2, lines 32-47, and the entire document . It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the opening in the magnet device in Miller for inserting an eyeglass temple piece therein instead of the stems of flowers for holding eyeglasses including the use of different type of material to form it magnet in the manner taught, disclosed and suggested by Ward, II and Markowitz, respectively, especially, since such modification involves only routine skill within the art . **Furthermore, the particular type of material used to forms its magnet is considered no more than an obvious matter of design choice within the skill in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice . See In Re Leshin, 125 USPQ 416.**

As to the method as recited in claim 24, it would obviously and inherently be within the scope of the references as applied .

5. Claim 20, rejected under 35 U.S.C. 103(a) as being unpatentable over the same references as applied to claim 14, above, and further in view of McIntosh U. S. Patent No. 3,159,372 (of record) who teaches the use of a magnet formed of magnetized rubber or similar material for elastically and frictionally gripping an article ; see Figure 1, 2; column 1, lines 21-44, and the entire document and to further incorporate the use of such material in Miller, in the manner taught and suggested by McIntosh, it would have been obvious to one having ordinary skill in the art at the time the invention was made .

6. Claims 21-23, are rejected under 35 U.S.C. 103(a) as being unpatentable over the same references as applied to claim 14, above, and further in view of Wakefield U. S. Patent No. 2,363,914 (of record) and Mizuno U. S. Patent No. 3,129,477 (newly cited) . Wakefield teaches the use of two magnets and two magnet housing members, wherein, each of said magnet housing members adapted to receive one said magnet ; see Figures 1-3 . Mizuno teaches the use of a flexible chain connected to magnetic housing members ; see Figure 1, and to further incorporate such structure in Miller in the manner taught and suggested by Wakefield and Mizuno, it would have been obvious to one having ordinary skill in the art at the time the invention was made, especially, since the use of such structure is conventional and well known within the art .

7. Claim 18, is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The use of a plurality of references is justified since some of the limitations to which they are applied are independent of each other ; see Ex Parte Fine 1927 C. D. 84 ; O. G. 511 .

Response to Arguments

9. Applicant's arguments with respect to claims 14-17 and 19-24, have been considered but are moot in view of the new ground(s) of rejection.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's attention is directed to the prior art of record, but not applied, as showing structure related to Applicant's disclosed invention .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Victor Sakran** whose **telephone number is (703) 308-2224**. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight, can be reached on (703) 308-3179. The **fax phone number for this Group is (703) 305-3597 or 305-3598.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

VICTOR SAKRAN
PRIMARY EXAMINER
ART UNIT 3626

June 11, 2001